

-2-

REMARKS

Claims 1-38 remain pending in this application. Of these, Claims 10-38 are withdrawn from consideration as being directed to non-elected inventions.

In the Office Action, Claims 1-6 and 9 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. 6,681,021 to Saltykov ("Saltykov"), and Claims 7-8 were rejected under 35 U.S.C. § 103 as being unpatentable over Saltykov in combination with U.S. 5,606,621 to Reiter *et al.* ("Reiter"). In view of the following remarks, it is believed that these rejections are overcome, and that the present claims are allowable.

The Examiner rejected Claim 1 as being unpatentable over Saltykov, stating that Saltykov discloses a hearing aid comprising a first and second "half shell" attached to each other. The Examiner has incorrectly interpreted Saltykov's reference to a "half shell." A person skilled in the art of hearing aids would understand that Saltykov's reference to a "half shell" is referring to the overall physical size of the hearing aid. As hearing aids became smaller, the phrase "half shell" was coined to describe that the physical size of the hearing aid is "about half the size" of a typical ITE hearing aid of the day. Saltykov clearly defines this in column 1, lines 10-12 of the patent, where he states "including in the ITE type are so-called 'half shell' aids, which are smaller than full size ITE aids but are larger than canal aids."

Saltykov does not teach or suggest the literal "first half shell" and "second half shell" of present Claim 1, where the two partial shells are joined together to form a full housing that encloses the hearing aid components and conforms to the shape of an ear canal. On the contrary, Saltykov clearly teaches that the full hearing aid housing 2 is "of the 'half shell' type." (Col. 3, lines 38-40). Saltykov does not teach or suggest a first "half" (*i.e.* partial) shell and a second "half" (*i.e.* partial) shell that are joined together to form the full hearing aid housing, as is recited in the present claims. In fact, Saltykov appears to teach that the "half-shell type" hearing aid includes a full, unitary housing (see Fig. 1), and not the two partial shells of the present invention. At the time of the present invention, the term "half-shell type" hearing aid, as used in the context of the Saltykov reference, had a well-understood meaning in the art as being "about half the size" of a typical ITE. Accordingly, this is how the reference to a "half shell type" hearing aid would be understood at the time of the present invention, and one skilled in the art (without the benefit of hindsight afforded by the present invention) would undoubtedly not

-3-

understand Saltykov as teaching or suggesting the two half shell design of the present invention. Since this feature is not taught or suggested in the Saltykov reference, it is respectfully submitted that the rejection of independent Claim 1 is overcome.

In addition, the deficiencies with respect to Saltykov are not overcome by the secondary Reiter reference, since Reiter relates to a hybrid behind-the-ear and in-the-ear device, and fails to teach or suggest numerous limitations of Claim 1, including at least the limitations of a first half shell and a second half shell; a housing formed by the two half shells that conforms to the shape of an ear canal; a microphone, battery and electronics being mounted within the housing formed by the half shells; and the mechanical securing mechanism for the half shells.

Reliance on "Common Knowledge" For Allegedly Teaching Numerous Features of Claims 1-9

The Examiner concedes that Saltykov does not teach numerous other limitations of Claims 1-9, but concludes that these missing features are "very well known in the art," and would have been obvious to include in the hearing device of Saltykov. More specifically, the Examiner admits that Saltykov does not teach the "flexible tip" limitation of independent Claim 1; the "interlocking joint" securing mechanism of Claim 2; the "microphone retainer" limitation of Claims 4-5; the "mushroom-shaped tip" limitation of Claim 6; and the "adhesive seal" of Claim 9. (It is noted that the Office Action does not at all address the limitation of Claim 3 that the hearing aid comprises an aperture to allow a potting material to be introduced into the hearing aid. Absent any finding that this limitation is taught or suggested in the prior art, it is submitted that Claim 3 should be allowed).

Applicants question the propriety of the Examiner's reliance on "official notice" or "common knowledge" in the art, without citation to any documentary evidence, as the principal evidence for at least five different features in the present claims, particularly since this application is under final rejection, and the applicants were not given an opportunity to respond to the Examiner's allegations. See M.P.E.P. § 2144.03(A) ("While 'official notice' may be relied on, these circumstances should be rare when an application is under final rejection"). Furthermore, applicants respectfully disagree with the Examiner's apparent conclusions that the relevant features in the claims are of such a notorious character as to justify the Examiner taking official notice. For example, Applicants disagree with the Examiner's contentions that it is

-4-

common knowledge in the art to provide a flexible tip for a hearing aid as is otherwise specified in Claim 1; or to provide an "interlocking joint" as is recited in Claim 2; or to provide a "microphone retainer" as is specified in Claims 4 and 5; or to provide a "mushroom shaped tip" for a hearing aid as is otherwise specified in Claim 6; or to provide an "adhesive seal" between two half-shells, as is recited in Claim 9. Applicants respectfully request that the Examiner provide documentary evidence for these allegations, and/or an affidavit or declaration setting forth specific factual statements and explanations in support of these allegations if these rejections are maintained in the next action. See M.P.E.P. § 2144.03(C). In the absence of such evidence, however, it is submitted that the Examiner has not satisfied his *prima facie* burden of demonstrating the obviousness of the present claims, and that Claims 1-9 should be allowed.

Request for Rejoinder of Claim 38

In the Office Action, dependent Claim 38 was withdrawn from consideration. The Examiner stated that this claim is directed to an invention that is independent or distinct from the invention originally claimed because the limitation of "the battery is substantially permanently affixed within the housing" was not originally claimed.

Applicants respectfully submit that this new restriction requirement between Claims 1-9 and Claim 38 is improper, and request rejoinder of Claim 38. M.P.E.P. § 821.03 specifies that where the applicant presents new claims after an office action (as is the case with Claim 38), the applicant will be required to restrict the claims to the previously claimed invention, but only where the claims are "to an invention distinct from and independent of the invention previously claimed." See 37 C.F.R. § 1.145. In the present case, the Examiner has not made an adequate showing that the subject matter of Claim 38 is independent or distinct from the subject matter of Claims 1-9. Indeed, the only reason the Examiner gives for Claim 38 being independent or distinct is that it adds a new limitation that was not originally claimed. Applicant's submit that this is not a sufficient showing of an "independent or distinct" invention, since the mere fact that a new limitation has been presented does not automatically render the new claim "independent or distinct." At a minimum, the Examiner must provide reasons to support the conclusion that the new limitation constitutes an independent or distinct invention. See M.P.E.P. § 803.

-5-

Furthermore, the applicants do not believe that there is any "serious burden" on the Examiner that would justify a restriction requirement between Claims 1-9 and Claim 38. It is noted that Claim 38 is a dependent claim that depends directly on independent Claim 1. The Examiner has not alleged that the subject matter of Claims 1 and 38 have a separate status or classification in the art, or that a different field of search would be required for examination of Claim 38.

In any event, it is believed that independent Claim 1 is allowable for the reasons discussed above. If the Examiner determines that the subject matter of Claim 1 is allowable, then it is requested that the narrower dependent Claim 38 be rejoined for allowance.

CONCLUSION

In view of the above remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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